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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,825

03/18/2004

Scott Goldthwaite

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11/17/2006

AKC PATENTS

215 GROVE ST.

NEWTON, MA 02466

EXAMINER

FERGUSON, KEITH

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,825

Applicant(s)

GOLDTHWAITE ET AL.

Examiner

Keith T. Ferguson

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,22,23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-21,24-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Art Unit: 2617

DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,4-9 and 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benson in view of Arqués et al..

Regarding claims 1,4,5,7,8,14-20, Benson discloses a system (network) (col. 1 lines 9-13 and col. 2 lines 19-50) for performing mobile authentication service transaction (interconnection) between a mobile phone and a network (mobile transactions) (information exchange transaction) (col. 1 lines 9-13 and col. 2 lines 19-50) comprising: a mobile communication device (fig. 4) comprising a subscriber identification module (SIM) card socket (slot) (fig. 4 number 12) and a phone interface logic interface (virtual subscriber identification) (VSIM) interface (fig. 4 number 11) connected to said SIM card slot (fig. 4); a network service provider (server device) (server computer) (col. 3 lines 1-10); and wherein said mobile communication device is adapted to connect to said server device via a first wireless network (col. 3 lines 1-10 and col. 3 lines 53-67), provides subscriber identity authentication to said server device via said a phone interface logic (VSIM) (inherent,

Art Unit: 2617

since the phone interface logic is attached to the SIM Socket taught in fig. 4 and provide subscriber identification to the network provider, taught in (col. 1 lines 9-13 and col. 2 lines 19-50), a CPU (fig.4 number 10) (mobile transaction client application) for managing said communication between said mobile communication device and said server device (i.e. mobile phone replying its identification to the network provider) (col. 2 lines 10-30) and a mobile transaction server application for managing communication between said server and said mobile communication device (col. 1 lines 24-34). Benson differs from claim 1 of the present invention in that it does not disclose the mobile phone manages communication with said server device utilizing SIM Application Toolkit commands to invoke the Bearer Independent Protocol described in the European Telecommunications Standards Institute document ETSI TS 101 267 (3GPP TS 11.14). Arques et al. teaches a system (fig. 1) wherein a mobile station SIM card allows a distant server to perform authentication a subscriber identity using SIM Application Toolkit commands to invoke the Bearer Independent Protocol described in the European Telecommunications Standards Institute document GSM 11.14) (P:0007 line 1 through P:008 line 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato with the mobile phone manages communication with said server device utilizing SIM Application Toolkit commands to invoke the Bearer Independent Protocol described in the European Telecommunications Standards Institute document ETSI TS 101 267 (3GPP TS 11.14) in order for the system to provide a security transaction layer session according to a protocol used by the mobile phone's SIM when accessing an internet network, as taught by Arques et al..

Regarding claim 6, Benson discloses one or more additional SIM slots, a second SIM card connected to one of said one or more additional SIM slots and a smart card reader (col. 3 lines 1-35 and col. 6 lines 8-15).

Regarding claim 9, Benson discloses a system as discussed supra in claims 1 and 8 above. Benson differs from claim 9 of the present invention in that it does not disclose said wireless telecommunications network is a Global System for Mobile Communications (GSM). Arques et al. teaches a network that is a Global System for Mobile Communications (GSM) (P:0007 lines 1-

Art Unit: 2617

12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Benson with said wireless telecommunications network is a Global System for Mobile Communications (GSM) in order to provide the system ETSI standards specifying the infrastructure for a digital cellular service which coordinates with the mobile phone SIM, as taught by Arques et al..

Regarding claim 13, Benson discloses a Short Message Service (SMS) communication format (col. 3 lines 18-23).

4. Claims 21,24-29 and 31-40 are rejected under 35 U.S.C.

103(a) as being unpatentable over Sato in view of Arques et al..

Regarding claim 21,24,25,27,28,35,36-40, Sato discloses a method for performing mobile information exchange transactions (fig. 3) comprising: providing a mobile communication device (fig. 2) comprising a subscriber identification module (SIM) card socket (slot)(fig. 2 number 201 and 202) and a driver (fig. 2 numbers 241 and 242)(virtual subscriber identification) (VSIM) interface connected to said SIM card slot (fig. 2); providing a server device with a network (p:0037 line 1 through p:0039 line 13 and fig. 14 number 14); connecting said mobile communication device to said server device via a first network (p:0037 line 1 through p:0039 line 13 and fig. 14 number 14); providing subscriber identity authentication of said mobile communication device to said server device via said VSIM interface (p:0005 lines 1-5, p:0029 lines 1-11 and (p:0037 line 1 through p:0039 line 13 and fig. 14 number 14); and communicating between said mobile communication device and said server device (p:0037 line 1 through p:0039 line 13 and fig. 14 number 14), a hardware control unit HWC (fig. 2 number 103)(mobile transaction client application) for managing said communication between said mobile communication device and said server device (p:0037 line 1 through p:0039 line 12 and fig. 14 number 14) and a mobile transaction server application for managing said communication between said server and said mobile communication device (Korea charges the mobile telephone for call services)(P:0079 lines 1-10). Sato differs from claim 21 of the present invention in that it does not disclose said mobile communication device manages said communication utilizing SIM Application Toolkit commands to invoke the Bearer Independent Protocol described in the European Telecommunications Standards Institute document

Art Unit: 2617

ETSI TS 101 267 (3GPP TS 11.14). Arques et al. teaches a mobile station SIM card allows a distant server to perform authentication a subscriber identity and governed by a SIM Application Toolkit commands to invoke the Bearer Independent Protocol described in the European Telecommunications Standards Institute document GSM 11.14) which defines a set of commands and situations between the mobile station and SIM card (P:0007 line 1 through P:008 line 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Benson with the mobile phone manages communication with said server device utilizing SIM Application Toolkit commands to invoke the Bearer Independent Protocol described in the European Telecommunications Standards Institute document ETSI TS 101 267 (3GPP TS 11.14) in order for the system to provide a security transaction layer session according to a protocol, commands and situations used by the mobile phone's SIM when originating a data call in Korea so that the mobile telephone can be charge for the data call services, as taught by Arques et al..

Regarding claim 26, Sato discloses one or more additional SIM slots (fig. 2 number 201 and 202), a second SIM card connected to one of said one or more additional SIM slots (fig. 2 number 1002), and an external card reader (fig. 2 number 102a).

Regarding claim 29, Sato discloses a Global System for Mobile Communications (GSM) (p:0003 lines 1-5).

Regarding claims 31,32 and 34, Sato discloses said first network is adapted to connect to a second wireless network (40) through a mobile operator gate and wherein said server is adapted to connect to said second network thereby connecting to said first network (42) and said mobile communication device (fig. 14 and P:0079 line 1 through P:0081 line 8).

Regarding claim 33, Sato discloses a method as discussed supra in claim 21 above. Sato differs from claim 33 of the present invention in that it does not disclose said communication comprises a Transmission Control Protocol/Internet

Art Unit: 2617

Protocol (TCP/IP) format. Arques et al. teaches communication that uses a Transmission Control Protocol/Internet Protocol (TCP/IP) format (P:0008 line 1 through P: line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sato with said communication comprises a Transmission Control Protocol/Internet Protocol (TCP/IP) format in order for transaction to guarantee integrity and reliability data communication when the mobile telephone seeks an internet communication connection in Korea, as taught by Arques et al..

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Arques et al. as applied to claim 21 above and in further view of Goldberg et al..

Regarding claim 30, the combination of Sato and Arques et al. differs from claim 30 of the present invention in that they do not disclose said first network is a Bluetooth network. Goldberg et al. teaches a personal Bluetooth network (p:0051 lines 1-4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made To modify the combination of Sato and Arques et al. with said first network is a Bluetooth network in order for the mobile telephone to pay for call charges by having it SIM card debited by a short range debit call station, as taught by Goldberg et al.

6. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benson in view of Arques et al. as applied to claim 1 above and in further view of Goldberg et al..

Regarding claim 10, the combination of Benson and Arques et al. differs from claim 10 of the present invention in that they do not disclose said first network is a Bluetooth network. Goldberg et al. teaches a personal Bluetooth network (p:0051 lines 1-4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made To modify the combination of Benson and Arques et al. with said first network is a Bluetooth network in order for the system to

Art Unit: 2617

verify the mobile phone identification using short range communication, as taught by Goldberg et al..

Regarding claims 11 and 12, the combination of Benson and Arques et al. differs from claim 11 of the present invention in that they do not disclose said first network is adapted to connect to a second network through a mobile operator gate and wherein said server is adapted to connect to said second network thereby connecting to said first network and said mobile communication device. Goldberg et al. teaches a first network (fig. 2 number 16) is adapted to connect to a second wireless network (fig. 2 number 18) through a mobile operator gate and wherein said server is adapted to connect to said second network thereby connecting to said first network and said mobile communication device (P:0028 line 1 through P:0030 line 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Benson and Arques et al. with said first network is adapted to connect to a second network through a mobile operator gate and wherein said server is adapted to connect to said second network thereby connecting to said first network and said mobile communication device in order for the system to allow the mobile phone an internet connection from a GSM network to a packet data network, as taught by Goldberg et al..

Response to Arguments

7. Applicant's arguments filed August 29, 2006 have been fully considered but they are not deemed to be persuasive. The following are explanations to the applicant arguments:

8. Argument: Regarding claim 1, applicant alleges that Argues et al. does not disclose a mobile station SIM allows a distant server to perform authentication a subscriber identity utilizing SIM Application Toolkit commands to invoke the Bearer Independent Protocol described in the European Telecommunications Standards Institute document ETSI TS 101 267 (3GPP TS 11.14).

Art Unit: 2617

Explanation: Examiner agrees with applicant. However, claim 1 does not recite "a mobile station SIM allows a distant server to perform authentication a subscriber identity utilizing SIM Application Toolkit commands to invoke the Bearer Independent Protocol described in the European Telecommunications Standards Institute document ETSI TS 101 267 (3GPP TS 11.14)". Benson teaches an authentication interconnection process between a cellular telephone SIM card and a network. Argues et al. teaches utilizing SIM Application Toolkit commands to invoke the Bearer Independent Protocol described in the European Telecommunications Standards Institute document ETSI TS 101 267 (3GPP TS 11.14) between a mobile terminal and its SIM card.

9. Argument: Regarding claims 1 and 21, applicant alleges that Argues et al. does not disclose any reference to authentication service.

Explanation: Examiner respectfully disagrees because Argues et al. teaches in paragraph 0007, FIG. 1, describes schematically the communication within a mobile station 10 composed of an item of mobile equipment ME, a telephone in the example, and a smart card SIM. The mobile station 10 can communicate with another mobile station 10' or with a distant server 100. The SIM card makes it possible to procure a subscriber identification and a key in order to allow on the one hand the authentication of the subscriber on the GSM network and on the other hand the decrypting or encrypting of the data received or sent. The SIM card also enables the subscriber to access data peculiar to the GSM network and information on the services accessible.

10. Argument: Regarding claims 3,4,22 and 23, applicant alleges that Benson CPU is a hardware component and not a software application that manages the communication from the mobile communication device to the server device.

Explanation: Examiner respectfully disagrees, applicant did not address a "software application" in claims 3 and 4. Also, it is known in the wireless/cellular art for the communication device CPU to interact with software stored within (i.e. memory, memory card, SIM, etc.) that manages the communication from the mobile communication device to the server device for authenticating before allowing a cellular telephone wireless service.

Art Unit: 2617

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T. Ferguson whose telephone number is (571) 272-7865. The examiner can normally be reached on 6:30am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the

Art Unit: 2617

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keith Ferguson
Art Unit 2617
November 1, 2006

KEITH FERGUSON
PRIMARY EXAMINER

